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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,865

03/11/2004

Harold D. Beck

03-36

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7590

04/26/2006

DAYCO PRODUCTS, LLC
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MIAMISBURG, OH 45342

EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,865

Applicant(s)

BECK, HAROLD D.

Examiner

Vickey Ronesi

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 12-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 2/20/2006 is not in compliance because new claims 39 and 40 have underlining and cross-out marking indicative of an amended claim. In the interest of compact prosecution, all of the claims have been examined.
2. All outstanding objections and rejections, except for those set forth below, are withdrawn in light of applicant's amendment filed 2/20/2006.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. The new grounds of rejection set forth below are necessitated by applicant's amendment filed 2/20/2006. In particular, the claims have been amended to specify basis for amounts. Thus, the following action is properly made final.

Election/Restrictions

5. Applicant's election without traverse of Group I in the reply filed on 2/20/2006 is acknowledged.

Claims 12-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/20/2006.

Specification

6. The amendment filed 2/20/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall

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introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: relative amounts of vinyl acetate and comonomers are without basis in the specification as originally filed. Hence, the amendment of "by weight" in regards to the amounts is new matter. Applicant cannot merely state that a basis of weight % is "customary" in the attorney's remarks and insert a basis of weight % in the claims. To overcome this rejection, applicant is advised to provide a declaration filed under 37 CFR 1.132 with an appropriate statement and objective evidence that supports applicant's statement.

Additionally, the use of relative term "about" with respect to new amounts is new matter (e.g., "0 to about 75 % by weight ethylene-vinyl acetate" and "0 to about 10 % by weight metal oxides"). See the third full paragraph on page 8 and the first full paragraph on page 9 bridging pages 9 and 10.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

7. Applicant is advised that should claims 10 and 11 be found allowable, claims 39 and 40 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 5, 7, 9-11, 39, and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 5, 10, 11, 39, and 40 the addition of basis for the relative amounts of comonomer in the elastomeric copolymer (i.e., % by weight) is new matter. No support is found for such a basis in the specification as originally filed. Applicant cannot merely state that a basis of weight % is "customary" in the attorney's remarks and insert a basis of weight % in the claims. To overcome this rejection, applicant is advised to provide a declaration filed under 37 CFR 1.132 with an appropriate statement and objective evidence that supports applicant's statement.

With respect to claims 7, 11, and 40, the addition of basis for the relative amounts of comonomer in the elastomeric polymer (i.e., % by weight) is new matter. No support is found for such a basis in the specification as originally filed. Applicant cannot merely state that a basis of weight % is "customary" in the attorney's remarks and insert a basis of weight % in the claims. To overcome this rejection, applicant is advised to provide a declaration filed under 37

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CFR 1.132 with an appropriate statement and objective evidence that supports applicant's statement.

With respect to claims 9-11, 39, and 40, the use of relative term "about" with respect to new amounts is new matter (e.g., "0 to about 10 % by weight metal oxides" and "0 to about 7% by weight adipate type plasticizer").

Claim Rejections - 35 USC § 102

9. Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartman et al (US 5,173,317).

Note that the preamble "automotive component" and "for the manufacture of automotive hoses, belts, seals, dampers and engine mounts which require resistance to heat, pressure and hydrocarbon fluids" have not been given patentable weight. Case law holds that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." See *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

Hartman et al discloses a chewing gum composition comprising a 10-45 wt % vinyl laurate/vinyl acetate copolymer containing 10-45 wt % of vinyl laurate (col. 2, lines 23-47); polyisobutylene (col. 2, lines 48-50); and other additives such as plasticizers (col. 2, lines 57 to col. 3, line 6) and fillers, texturizers, colorants, and antioxidants (col. 4, lines 5-38). See Table 1 in Col. 4 for exemplified amounts of ingredients. The limitation "exhibiting improved heat resistance, pressure resistance, and fluid impermeability" is inherently met by Hartman et al since it clearly anticipates the presently claimed composition. Case law holds that a material and

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its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In light of the above, it is clear that Hartman et al anticipates the presently cited claims.

10. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Amelia et al (US 4,968,511).

Note that the preamble "automotive component" and "for the manufacture of automotive hoses, belts, seals, dampers and engine mounts which require resistance to heat, pressure and hydrocarbon fluids" have not been given patentable weight. Case law holds that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." See *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

D'Amelia et al discloses a chewing gum composition comprising 1.5-25 wt % of certain vinyl polymers containing copolymers of vinyl alkyl esters (col. 4, line 30 to col. 5, line 28), copolymers of ethylene and vinyl alkyl esters (col. 5, line 30 to col. 6, line 36), and mixtures thereof (col. 7, lines 52-53); and up to 20 wt % fillers and plasticizers (see examples, e.g., Table 1). The limitation "exhibiting improved heat resistance, pressure resistance, and fluid impermeability" is inherently met by Hartman et al since it clearly anticipates the presently claimed composition. Case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In light of the above, it is clear that D'Amelia et al anticipates the presently cited claims.

Claim Rejections - 35 USC § 103

11. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenboom et al (US 6,464,607) in view of D'Amelia et al (US 4,968,511).

The rejection is adequately set forth in paragraph 13 of Office action mailed 10/26/2005 and is incorporated here by reference.

12. Claims 10, 11, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenboom et al (US 6,464,607) in view of D'Amelia et al (US 4,968,511) and further in view of Williams (US 5,492,971) and Barclay et al (US 2002/0042464).

With respect to claims 10 and 11, the rejection is adequately set forth in paragraph 14 of Office action mailed 10/26/2005 and is incorporated here by reference.

With respect to new claims 39 and 40, the rejection over claims 10 and 11 also covers the new claims.

Response to Arguments

13. Applicant's arguments filed 2/20/2006 have been fully considered but they are not persuasive. Specifically, applicant argues that the combination of Rosenboom et al with D'Amelia is improper since they are non-analogous art. In particular, Rosenboom is to a power transmission belt composition and D'Amelia is to a chewing gum composition.

With respect to the argument, while Rosenboom and D'Amelia disclose compositions which have different intended uses, it is the examiner's position that both pieces of art are to elastomeric compositions containing vinyl acetate elastomers and thus considered quite relevant.

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Applicant's claims are to a composition. In this regard, Rosenboom and D'Amelia are in the same field of endeavor. Case law holds that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/24/2006
Vickey Ronesi

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